Remarks/Arguments:

Claims 21 and 22, presented hereby, are pending.

Claims 1-20 are canceled, hereby, without prejudice or disclaimer.

Present claims 21 and 22 correspond to claims 15 and 16 rewritten as independent claims.

The objection to claim 18 is rendered moot by cancellation of the claim, hereby.

As indicated in the amendment to the drawings, proposed drawing corrections are presented, hereby, with respect to Figures. 10A,B, 10C,D, and Figures. 14, 15, and 18.

Claims 1-15, 17 and 20 were rejected under 35 USC §101 as allegedly claiming the same invention as in claims 1-17 of U.S. 6,376,843. Claims 16, 18, and 19 were rejected under the judicially created doctrine of obviousness-type double patenting based on claims 1-17 of U.S. 6,376,843 (Palo). Reconsideration of the aforesaid rejections is requested.

In order for a double patenting rejection under §101 to apply, the claims of the patent must define the "same invention" as the claims in the application. *In re Vogel*, 164 USPQ 619, 621 (CCPA 1970).

> By "same invention" we mean identical subject matter. Thus the invention defined by a claim reciting "halogen" is not the *same* as that defined by a claim reciting "chlorine," because the former is broader in scope than the latter.
>
> 164 USPQ at 621-22.

The rejection as applied against claims 1-14, 17, and 20 is rendered moot, by cancellation of these claims, hereby.

As applied against claim 15, i.e., represented by present claim 21, none of claims 1-17 of Palo has an identical claim scope. That is, the present claims contain limitations not found in Palo, i.e., the limitations:

the spatial brightness profile is modeled by the following expression:

$$\frac{dV}{dx} = A_0 x(1 + a_1 x + a_2 x^2),$$

Since the claims relied on to reject the present claims under §101 do not have the same, identical scope as rejected claim 15, i.e., present claim 21, the §101 rejection cannot be maintained. *Vogel, supra.*

With respect to the rejection of claim 16 for alleged obviousness-type double patenting, the statement of rejection alleges:

> Although the conflicting claims are not identical, they are not patentable distinct from each other because claims 16[,] after rearrangement of the parameters[,] recites the same empirical relationship between the volume V and the brightness x as claimed in claim 15 of Patent 6,376,843 but with different constants.

An argument by the PTO is "not prior art." *In re Rijckaert*, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993). Between "*patentably distinct* inventions . . . there cannot be [obviousness-type] double patenting." *General Foods Corp. v. Studiengelschaft Kohle m.b.H.*, 23 USPQ2d 1839, 1843 (Fed. Cir. 1992).

> Our precedent makes clear that the *disclosure* of a patent in support of a double patenting rejection cannot be used as though it were prior art, *even where the disclosure* is found in the claims. . . . "[P]atent claims are looked to only to see what *has been patented*, the subject matter which *has been patented*, not for something one

> may find to be disclosed by reading them." *In re Aldrich*, 398F.2d 855, 851, 1580 U.S.P.Q. 311, 314 (CCPA 1968)

23 USPQ2d at 1846 (*emphasis in original*). An obviousness-type double patenting rejection is "not . . . concerned with what one skilled in the art would be aware [of] from *reading* the claims but with *what inventions the claims define*". *In re Sarett*, 140 USPQ 474, 481 (CCPA 1964) (*emphasis in original*).

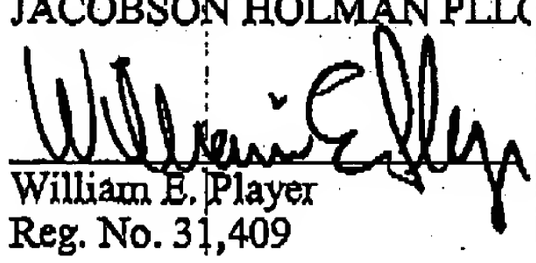
The statement of rejection explains neither (1) how the claim parameters are *rearranged* nor (2) how this "rearrangement" effects "the same empirical relationship between the volume V and the brightness x as claimed in claim 15 of Patent 6,376,843, nor (3) how the "different constance" would have been an obvious modification of patent claim 15.

Accordingly, the statement of rejection relying solely on argument, alone, the rejection for alleged obviousness-type double patenting cannot be maintained. *Rijckaert, supra*,

Favorable action is requested.

Respectfully submitted,

JACOBSON HOLMAN PLLC

By 
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Attachments: Figures 10A,B and 10C,D and Figures14A, 14B 15A, 15B, 18A, and 18.